

REMARKS

In response to the Office Action dated March 3, 2004, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-7 and 21-28 were rejected under 35 U.S.C. § 103 as being unpatentable over Zoken (U.S. Patent 5,944,787) in view of Donaldson (U.S. Patent 6,321,267). Claims 8-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Zoken in view of Donaldson and in further view of Rollins (U.S. Patent 6,434,601). Independent claims are claims 1, 8, 18, 21 and 26.

Claims 1-28 are pending. Independent claims 1, 8, 18, 21 and 26 have been amended to clarify the invention. Support for the clarification can be found in the specification of the present application at, for example, page 6, line 2-6. Dependent claims 19-20 have been amended to correct matters of form. No new matter has been added. No claim has been added or cancelled. Accordingly, claims 1-28 will be pending.

First, Applicant respectfully contends that at least one element of each of the independent claims is not disclosed in any of the references applied in the Office Action. Therefore, the references cannot be combined to render the pending claims obvious.

As amended, claim 1 recites:

A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

storing a list of domain names in a memory;

checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the list of domain names in the memory; and

generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication if the domain name is not included in the list of domain names.

As emphasized above, the invention recited in claim 1 relates to a method that checks whether the domain name of the e-mail address associated with an intended recipient of an outgoing e-mail communication is correct by comparing it with a list of known domain names previously stored in a memory. This element is similar recited in each of the remaining independent claims 8, 18, 21 and 26. This element is not taught or suggested in any of the references applied in the Office Action.

For example, Zoken relates to a method for automatically finding a postal address of a sender based on the sender's e-mail address that is found in the e-mail. Zoken does not check whether a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the list of domain names in the memory, as recited in the claims of the present invention. The passage of Zoken referenced in the Office Action, column 5, line 28 to column 5, line 12, explains how different databases can be searched to find the sender's postal address. Indeed, checking the email address of the intended recipient would not enable the retrieval of the postal address of the sender.

Similarly, Donaldson does not teach the element of checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the list of domain names in the memory. Donaldson relates to a junk email filtering method that scrutinizes an incoming email to determine whether the incoming email should be

blocked. Indeed, checking the email address of the intended recipient of an outgoing email would not help in any way the filtering of incoming junk emails.

Finally, Rollins does not teach or suggest checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the list of domain names in the memory, which is recited in independent claims 1, 8, 18, 21 and 26. What Rollins teaches, from column 3, line 55 to column 4, line 21, is a method that instructs an e-mail program associated with a sender of an email to executes a ping to an email server associated with an addressee of the email. Depending on whether the email server of the addressee responds to the ping, the e-mail program of the sender would then inform the sender whether the email address of the addressee should be corrected. Rollins therefore does not teach checking the e-mail address of the intended recipient with a list of domain names that are stored in a memory of the email program, as recited in the independent claims of the present invention. In fact, Rollins teaches away from the approach of the present invention. For example, from column 2, line 58 to column 3, line 6, Rollins provides that checking the addressees known to the local server of the sender is not sufficient to verify the validity of an addressee's email address, which motivated its invention of executing the ping to the email server of the addressee.

Since none of Zoken, Donaldson and Rollins, whether singly or in any combination thereof, teaches checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the list of domain names in the memory, Applicant believes that all the rejections of record have been overcome. Further, Applicant submits that no motivation can be reasonably inferred from any of the references

Serial No.: 09/725,717
Art Unit: 2142

Attorney's Docket No.: BS00-168
Page 13

applied to combine any of the references to arrive at the invention recited in the pending claims. Moreover, given the discussion above, Applicant does not believe any combination of any of the references applied in the Office Action would provide an expectation that the combination would be successful. Accordingly, Applicant believes that all pending claims are in condition for allowance.

Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative at the number listed below.

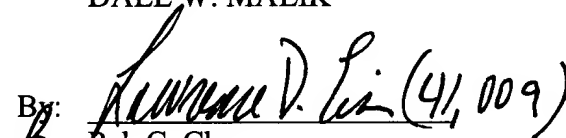
SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: 703-770-7696

Date: June 3, 2004

Respectfully submitted,

DALE W. MALIK

By:


Poh C. Chua
Registration No. 44,615

PCC/kmh